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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,084	08/27/2001	Makoto Syoda	213129US0PCT	1962

22850 7590 12/03/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

KUMAR, PREETI

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/926,084

Applicant(s)

SYODA ET AL.

Examiner

Preeti Kumar

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Final Rejection

Response to Amendment

1. Claims 1-20 are pending.
2. The rejection of claims 1-20 under 35 U.S.C. 102(b) as being anticipated by Kim et al. (Journal of Fermentation and Bioengineering, Vol. 79, No.6, 601-607, 1995) is withdrawn upon further consideration of the prior art.
3. The rejection of claims 1-20 under 35 U.S.C. 103(a) as obvious over Kim et al. (Journal of Fermentation and Bioengineering, Vol. 79, No.6, 601-607, 1995) is maintained for the reasons recited in the previous office action dated May 20, 2003 and further explained below.
4. The rejection of claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Kim et al. (Applied and Environmental Microbiology, Mar. 1999, p. 1029-1035) is maintained for the reasons recited in the previous office action dated May 20, 2003 and further explained below.

Response to Arguments

5. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive.

Applicants urge that the rejection of claims 1-20 under 35 U.S.C. 102(a) as being anticipated by Kim et al. (Applied and Environmental Microbiology, Mar. 1999, p. 1029-1035) is obviated by the perfection of priority under 37 C.F.R. 1.55. However, the court has held that a journal article or other publication becomes available as prior art on the

date it is received by a member of the public. Thus a technical journal is effective as of its date of publication (date when first person receives it) not the date it was mailed or sent to the publisher. Please refer to the MPEP 2128.02 and *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956). The journal article used in the rejection of claims 1-20 under 35 U.S.C. 102(a) as being anticipated by Kim et al. (*Applied and Environmental Microbiology*, Mar. 1999, p. 1029-1035) is not obviated by the perfection of priority since the article was received September 8, 1998, 5 months prior to the filing of the foreign priority document on February 26, 1999.

Regarding the traversal of the rejection of claims 1-20 under 35 U.S.C. 103(a) as obvious over Kim et al. (*Journal of Fermentation and Bioengineering*, Vol. 79, No.6, 601-607, 1995), Applicant's urge that the reference is too broad a teaching to be obvious over the instant claims. However, the examiner draws Applicant's attention to the discussion on page 606 where Kim et al. teach that in table 3, a comparison of the decolorizing activity between the culture broth and the crude enzyme solution is made. The degradation rate for the enzyme solution is seen to be significantly enhanced more than 100 fold for some of the dyes. As the crude enzyme solution was prepared from the culture broth after 3d cultivation when the growth of Dec 1 reached a stationary phase, and the enzyme activity lasted for a longer period of time, the peroxidase(s) produced by the fungus will be inducible. The dyes themselves are not inducers because the enzyme activity appeared in PD medium. Figure 4 shows two peaks of activity during cultivation period which may indicate the production of different kinds of

peroxidases, the involvement of enzymes other than peroxidases, or higher production of the same enzyme(s) at the later time.

Thus, it would have been obvious to one of ordinary skill in the art, to arrive at a peroxidase enzyme derived from *Geotrichum candidum* Dec 1 having the properties recited by the instant claims because Kim et al. suggest a peroxidase produced from *Geotrichum candidum* Dec 1 involved in the decolorization of dyes and would be expected to inherently have the same properties as recited by the instant claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

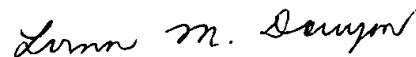
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Preeti Kumar whose telephone number is 703-305-0178. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on 703-308-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-872-9309.

Preeti Kumar
Examiner
Art Unit 1751

PK


LORNA M. DOUYON
PRIMARY EXAMINER